

REMARKS/ARGUMENTS

Status of the Claims

Upon entry of the present amendment, claims 1-83 are canceled without disclaimer or prejudice to renewal. New claims 84-92 are added and pending.

New claim 84 tracks the language of canceled claims 60 and 66, setting forth a method of using a recombinant or isolated *Campylobacter jejuni* α 2,3-sialyltransferase.

New claim 85 finds support, for example, on page 8, lines 30-31.

New claim 86 finds support, for example, on page 6, lines 1-9.

New claims 87-89 track the language of canceled claims 81-83.

New claims 90-91 find support, for example, on page 23, lines 11-14.

New claim 92 finds support, for example, on page 24, line 17 through page 25, line 4.

Applicants submit that no new matter is added by the present claim amendments, and respectfully request the Examiner to enter them.

35 U.S.C. § 112, first paragraph, enablement requirement

The Examiner has rejected claims 60 and 81-83 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. Claim 66, directed to using a *Campylobacter jejuni* α 2,3-sialyltransferase, was not included in this rejection.

Applicants do not agree with the Examiner. However, in the interest of furthering prosecution, Applicants provide claims directed to methods of sialylating a saccharide group on a recombinant glycoprotein using a recombinant or isolated *Campylobacter jejuni* α 2,3-sialyltransferase. The Examiner states that the specification is enabling for a method of sialylating a saccharide group on a recombinant glycoprotein using a *Campylobacter jejuni* α 2,3-sialyltransferase (*see*, page 2 of the Official Action mailed on June 15, 2005). Accordingly, the Examiner is respectfully requested to withdraw this rejection.

35 U.S.C. § 112, first paragraph, written description requirement

The Examiner has rejected claims 60 and 81-83 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Claim 66, directed to using a *Campylobacter jejuni* α 2,3-sialyltransferase, was not included in this rejection.

Applicants do not agree with the Examiner. However, in the interest of furthering prosecution, Applicants provide claims directed to methods of sialylating a saccharide group on a recombinant glycoprotein using a recombinant or isolated *Campylobacter jejuni* α 2,3-sialyltransferase. The Examiner states that those skilled in the art would recognize that Applicants were in possession of a method of sialylating a saccharide group on a recombinant glycoprotein using a *Campylobacter jejuni* α 2,3-sialyltransferase (*see*, page 8 of the Official Action mailed on June 15, 2005). Accordingly, the Examiner is respectfully requested to withdraw this rejection.

Double Patenting

The Examiner has rejected claims 60, 66 and 81-83 under the judicially created doctrine of double patenting as allegedly unpatentable over claims in U.S. Patent No. 6,399,336. Applicants will submit an appropriate Terminal Disclaimer upon a determination by the Examiner that the claims are otherwise allowable.

Provisional Double Patenting

The Examiner has rejected claims 60, 66 and 81-83 under the judicially created doctrine of double patenting as allegedly unpatentable over claims in U.S. Patent Application No. 10/081,456.

The '456 application is not an issued patent. To the extent that a non-statutory double-patenting rejection can be asserted at all, pursuant to M.P.E.P. § 804(I)(B), the Examiner should allege a double patenting rejection in the later pending patent application. Accordingly, the Examiner is respectfully requested to withdraw this rejection and allow the present application to issue.

Appl. No. 10/081,455
Amdt. dated February 15, 2006
Reply to Office Action of June 15, 2005

PATENT

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,



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Attachments
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